UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,192	09/17/1999	JOHN WANKMUELLER	AP31994-0704	1972

7590   09/29/2004

BAKER & BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 101120228

EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _07 July 2004_ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-13,17-29,33-45,49 and 50_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-13, 17-29, 33-45, 49 and 50_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6)☐ Other: .

Response to Amendment

This is in response to an amendment file on July 7th, 2004 for letter for patent filed on

September 17th, 2003 in which claims 1-50 were presented for examination. In the amendment,

claim 1 has been amendment. Claims 1-13, 17-29, 33-45, 49 and 50 remain pending in the letter.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims **1-13, 17-29, 33-45, 49 and 50** are rejected under 35 U.S.C. 102(b) as being

anticipated by Bush et al (U.S. Patent No. 5,263,162).

Re claim 1: Bush et al discloses a method for generating identification data (*deriving*

CGPIN), comprising providing (*read*) an ATM PIN (*pin code*) related to a first transaction type;

and performing a cryptographic operation (*perform encryption*) upon an ATM PIN (*PIN code*)

thereby generating (*derive*) a non ATM PIN (*CGPIN*) for use in a second transaction which is a

non ATM transaction (*comparing and matches*) (*see abstract, 5-7, column 3 lines 16-45, 4 lines*

42-5 line 15).

Re claim 2: Bush et al further discloses that the step of performing a cryptographic

operation comprises providing a conversion key (*pseudo-random number*) and using the

conversion key to perform said cryptographic operation upon an ATM PIN (*see column 2 lines*

21-42).

Re claim 3: Bush et al further discloses that the step of providing a conversion key comprises: providing conversion key derivation data (i.e., PAN) providing a conversion key derivation key and performing the cryptographic operation upon the conversion key derivation data and the conversion key derivation key (*see column 2 lines 21-42*).

Re claim 4: Bush et al further discloses that the step of performing a cryptographic operation upon the conversion key derivation data and the conversion key derivation key comprises using the conversion key derivation key to perform at least one cryptographic operation upon the conversion key derivation data (*see column 2 lines 21-42*).

Re claim 5: Bush et al further discloses that the conversion key derivation data includes an identification number that is associated with multiple accounts, and wherein at least one cryptographic operation using a secret key is performed to cryptographically process said conversion key derivation data to produce the conversion key (*see column 2 lines 21-42*).

Re claim 6: Bush further discloses that the step of performing a cryptographic operation comprises: providing cryptographically-computed data and performing an operation upon an ATM PIN and the cryptographically-computed data *(see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15)*.

Re claim 7: Bush further discloses that the step of providing cryptographically-computed data comprises: providing initial data and performing at least one cryptographic operation using a secret key upon the initial data thereby producing the cryptographically-computed data (*see column 2 lines 21-42*).

Re claim 8: Bush disclose that the at least one cryptographic operation using a secret key comprises at least one of a DES-encryption and a DES-decryption *(see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15)*.

Re claim 9: Bush further discloses that least a portion of the initial data is obtained from at least a portion of an account number *(see column 2 lines 21-42)*

Re claims 10 and 13: Bush disclose that the operation upon an ATM PIN and the cryptographically-computed data comprises either a subtraction operation or an addition operation *(see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15)*

Re claim 11 and 12: Bush further discloses that the step of providing cryptographically-computed data further comprises generating a cryptographically-computed number having a base corresponding to a base of a number representing the first set of identification data, wherein said cryptographically-computed number has a number of digits corresponding to a number of digits of said number representing an ATM PIN *(see column 2 lines 21-42)*.

Re claims 17-29, 33-45, 49 and 50: The claimed system would have been inherent to perform the method disclosed by Bush et al as stated above. Therefore, they are rejected under the same rationale.

Response to Arguments

3.   Applicant's arguments filed July 7th, 2004 have been fully considered but they are not persuasive.

a.   Applicant argue that the prior art (Bush et al) fail to teach a PIN that is in connection with an authorization process of a single transaction which the user initiates by inserting his or her PIN. Examiner respectfully disagrees with Applicant's characterization of the prior art. Bush et al teach an invention to allow a remote central computer facility or an authorization terminal to validate a cardholder's identity through the use of a PIN code entered into a chip card by the cardholder at the time of the desired validation. As an example, when a waiter collects a user's credit and PIN card and the bill, the cardholder would have previously entered his PIN code using a keypad. The waiter would then process the credit card in the usual manner, but would also place the PIN Card in an authorization terminal. The authorization terminal scans the PIN Card for an account number which is sent off to a central computer. *The central computer sends back a pseudo-random number which is used by the card to produce a CGIPIN.* The central computer also produces a CGIPIN using a duplicate process. The *authorization* terminal sends the CGIPIN to the central computer. If the CGIPINs match, authorization is granted. Note that while the authorization terminal could make the comparison, for better security, the central computer should make the comparison. Additionally, note that the cardholder's PIN code never leaves the PIN Card. It is the CGIPIN, a number derived from the user's PIN code, a unique array matrix, and a constantly changing pseudo-random number generated by the central computer, that is transmitted by the PIN card.

b.   Applicant also argues that as of claims 6-13, Examiner looks to Konheim reference as a basis for the rejection. However, Examiner meant to look to Bush et al for

the basis of rejection to claims 6-13. Examiner erroneously type Konheim in the

paragraphs.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).
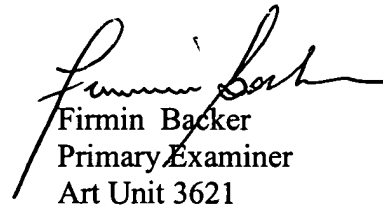
A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

September 26, 2004